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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/911,072 | 07/23/2001 | Udo Bickers | 514413-3888 | 2334 |

7590 07/02/2002

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| EXAMINER | |
|---|---|
| CLARDY, S | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1616 | |

DATE MAILED: 07/02/2002 10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/911,072 | Bickers et al |
| **Examiner** | **Art Unit** |
| S. Mark Clardy | 1616 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Apr 15, 2002* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-13* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *7, 8, 9*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claims 1-13 are pending in this application.

Applicants' claims are drawn to herbicidal compositions and their methods of use (especially against *Bromus* weeds, claims 7-8), as well as "use" of the compositions, and methods of making the compositions. The compositions comprise: a herbicidal component (sulfonylureas, e.g.: A1 A2 A3 A4 A5 mesosulfuron, rimsulfuron, nicosulfuron, iodosulfuron, foramsulfuron, compounds A1 - A5, p. 44), non-silicone surfactant(s), and humectant(s).

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6 and 9-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, i.e., the "use" of the compositions.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Griffin et al (US 4,441,917), Zeneca (PCT WO 96/00010), and Matsumoto et al[1].

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[1]Matsumoto et al. "Effect of Humectants on Pesticide Uptake through Plant Leaf Surfaces" Chapter 25 in *Adjuvants for Agrochemicals*, Chester Foy, ed. P. 261-271. 1992.

Griffin et al teach sulfonylurea herbicides which may be combined with various surface active agents (column 6), as well as other adjuvants such as humectants (col 7, line 1) for herbicidal activity against various weeds, including *Bromus tectorum* (Example 6, Table 4).

Zeneca teaches the combination of glyphosate with additional herbicidal agents such as sulfonylureas (p. 12, "U). Additives include various humectants (p. 7) and surfactants (p. 8-9).

Matsumoto et al teach that the addition of humectants to pesticidal (herein, 2,4-D and urea herbicides) compositions enhances the uptake of the active agents.

One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of humectants in herbicidal compositions.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined sulfonylurea herbicides, surfactants, and humectants in a single herbicidal composition because Griffin et al teach such combinations, and because the prior art teaches that surfactants and humectants are conventional additives in the herbicidal art.

With respect to claims 12 and 13, applicants have not presented any method-of-making claims that are anything other than merely combining the components and mixing by conventional means. Thus, the method of making is conventional and therefore obvious. Whether the final product is novel is not controlling of obviousness of the method. See In re Neugebauer, 141 USPQ 205. No particular method of mixing is stated; the simple act of mixing ingredients is old and unpatentable. In re Becket, 33 USPQ 33.

No unobvious or unexpected results are noted; no claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.

**S. Mark Clardy**
**Primary Examiner**
**AU 1616**

June 28, 2002